

REMARKS

1 The Examiner rejected claims 1-17 under 35 U.S.C. § 103(a) as being
unpatentable over U.S. Patent No. 6,709,617 to Wu in view of U.S. Patent No.
6,440,345 to Hellberg. Specifically, the examiner states that the Wu patent teaches
5 each of the steps within the claimed methods of providing a prosthetic socket. The
examiner states that the Wu reference appears to illustrate the positioning of the
residual limb in a substantially, positively flexed manner but appears not to explicitly
teach such positioning. However, the examiner finds, at column 4, lines 1-7, in the
Hellberg reference the teaching that such a flexed position of a stump when forming a
10 sleeve or socket is favorable. Accordingly, the Examiner argues that it would have been
obvious to one of ordinary skill in the art at the time the applicant derived the instant
invention to incorporate these teachings from the Hellburg reference in the method
taught by the Wu reference in order to derive the applicant's invention as claimed. The
15 applicant respectfully disagrees.

In determining the difference between the prior art and the claims, the question
under 35 U.S.C. § 103 is not whether the differences themselves would have been
obvious, but whether the claimed invention as a whole would have been obvious.
20 Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). A
prior art reference and the claimed invention must be considered in their entireties.
Distilling an invention down the "gist" or "thrust" of an invention disregards the
requirement of analyzing the subject matter "as a whole." W.L. Gore & Associates, Inc.

1 v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *Cert. denied*, 469 U.S.
851 (1984).

5 Claim 1 has been amended to define the "substantially positive flexion position" as being "an approximately ninety degree or greater flexion position". The specification describes this positioning in greater detail at page 6, lines 4-16. Neither Wu nor Hellberg teach or otherwise suggest such a position when the mold is being formed. Accordingly, giving full benefit to the teachings of both references, the prior art fails to provide the teachings, suggestions or motivations necessary to support a rejection of claim 1 under 35 U.S.C. § 103.

10 The mere fact that the references can be modified does not render the resulting modified structure obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). "A statement that modifications of the prior art meet the claimed invention and would have
15 been 'well within the ordinary skill in the art at the time the claimed invention was made because the references relied upon teach that all aspects of the claimed invention were individually known in the art' is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." Ex parte Leavengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

20 Just because a detail or step is simple and known for other purposes, does not render it "obvious". In re Kotzab, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000), the Federal Circuit Court of Appeals decided that the control of multiple valves by a single sensor rather than by multiple sensors was a technologically simple concept. However,

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1 the Federal Circuit held that there was no finding as to the specific understanding or
principal within the knowledge of the skilled artisan that would have provided the
motivation to use a single sensor as the system to control more than one valve. The
claimed limb and joint position when the mold is being made is an example of such a
5 patentable method born from a simple concept. More importantly, there is no teaching
or suggestion that would render the claimed method "obvious". Ex parte Leavengood,
28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). Accordingly, claim is believed to be
patentable. Likewise, claims 2-17 each ultimately depend from claim 1 and are believed
to be allowable for at least the reasons set forth herein with respect to claim 1. The
10 Examiner is respectfully requested to reconsider the aforementioned rejections and to
allow claims 1-17.

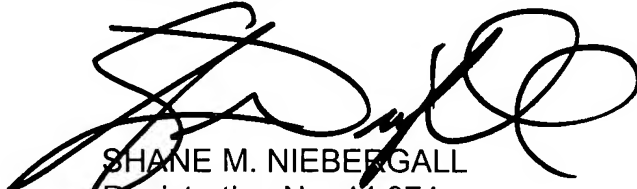
New claim 18 has been added that is based on original claim 1 but further defines
and limits the "substantially positive flexion position". Specifically, claim 18 describes
15 the step of "applying moldable means over at least a portion of the residual limb and
joint" in such a manner that requires the individual to "capture a shape formed by
femoral condyles within the limb as they naturally move into a proximal and anterior
position, moving forward and proximal at said substantially positive flexion position."
This can only be done when the joint is in a substantially positive flexion position.
20 However, a person of skill in the art will understand that the positions described and
shown in the prior art references are insufficient for creating such a shape because the
prior art positioning is not substantially positively flexed. Capturing this shape when
the mold is made will create a socket that allows for a natural, full range of motion
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1 during ambulation or various positions of flexion, such as when the individual is seated.
The prior art fails to enable this range of motion. Accordingly, new claim 18 should be
allowed.

5 In light of the above amendments and remarks, applicant asserts that the claims
are in condition for allowance. Applicant respectfully requests reconsideration and
allowance of the same.

No fees or extensions of time are believed to be due in connection with this
amendment; however, please consider this a request for any extension inadvertently
omitted, and charge any additional fees to Deposit Account No. 502093.

10 Respectfully submitted,

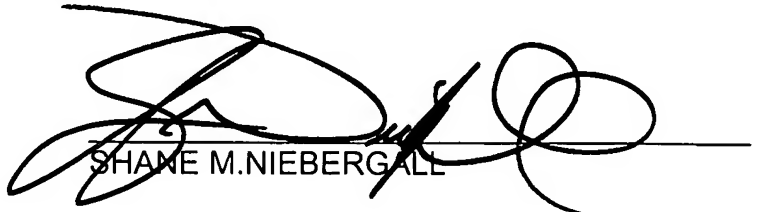


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CERTIFICATE OF MAILING

20 I hereby certify that the original of this AMENDMENT for RUSSELL F. BURTON,
Serial No. 10/783,232, was mailed by first class mail, postage prepaid, to Mail Stop
Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on
this 15th day of February, 2006.


SHANE M. NIEBERGALL